

Serial No. 10/797,092

OEPEN et al.

PF 50817-02

As summarized by the Examiner, "Ide discloses a thermoplastic impact resistant composition having high transparency, strength, surface hardness and toughness; said composition comprising a resin (I) that contains a copolymer of styrene, acrylonitrile and methyl-methacrylate and a graft component that can include a styrene-butadiene rubber, styrene and/or a copolymer of styrene and acrylonitrile, and (II) an organopolysiloxane."¹⁾ However, a review of the reference shows unequivocally that the resin (I) is composed of:²⁾

- (A) 10 parts by weight of polybutadiene or a certain styrene-butadiene rubber;³⁾ and
- (B) 15 to 190 parts by weight of a terpolymer of a monomer mixture consisting of certain amounts of styrene, methyl methacrylate and acrylonitrile.⁴⁾

The Examiner's statement that the resin (I) of Ide et al.'s composition comprises a component which "can include a styrene-butadiene rubber, styrene and/or a copolymer of styrene and acrylonitrile" is, accordingly, clearly in error. For clarification with a view to the examples which are described by Ide et al. and which might have contributed to the error, the following is noted.

The resins (I) can be prepared by a variety of methods and Ide et al. explain those methods in col. 3, indicated line 1 et seq., of US 3,919,157. Briefly,

- i) a first method comprises polymerizing the monomers of the terpolymer (B) in the presence of the rubber latex (A);⁵⁾
- ii) a second method comprises initially polymerizing a part of the ternary monomer mixture of (B) in the presence of the rubber latex (A) to obtain a so called graft-polymer latex, and subsequently mixing the graft-polymer latex with the terpolymer (B);⁶⁾ and
- iii) a third method comprises initially polymerizing a part of the ternary monomer mixture of (B) in the presence of the rubber latex (A) to form the graft-polymer latex corresponding to method

1) Cf. page 2, lines 11 to 15, of the Office action; emphasis added.

2) Cf. col. 1, indicated lines 14 to 21, of US 3,919,157.

3) Cf. also col. 1, indicated lines 49 to 55, and col. 2, indicated lines 17 to 38, of US 3,919,157.

4) Cf. also col. 1, indicated lines 55 to 61, and col. 2, indicated lines 46 to 59, of US 3,919,157.

5) Cf., e.g., col. 3, indicated lines 1 to 8, of US 3,919,157.

6) Cf., e.g., col. 3, indicated lines 8 to 17, of US 3,919,157.

Serial No. 10/797,092

OEPEN et al.

PF 50817-02

(ii), and subsequently polymerizing the remainder of the ternary monomer mixture of (B) in the presence of the graft-polymer latex obtained in the first polymerization stage.⁷⁾

The resins (I) are in either case composed of the constituents (A) and (B). Additionally, the graft-polymer latex which is encountered in the case of methods (ii) and (iii) is in either case composed of the rubber constituent (A) and the terpolymer constituent (B). Accordingly, the resin (I) of Ide et al. comprises no constituent which "can include a styrene-butadiene rubber, styrene and/or a copolymer of styrene and acrylonitrile."

The Examiner specifically referenced examples 1 to 3 of Ide et al. as disclosing "a resin composition comprising a graft copolymer latex containing a butadiene/styrene rubber and an acrylonitrile-styrene copolymer, an acrylonitrile-styrene-methacrylate terpolymer ..."⁸⁾ However, there is no disclosure of an acrylonitrile-styrene copolymer in the examples of Ide et al.

The molding composition which is employed in accordance with applicants' method consists essentially of

- (1) an elastomeric graft copolymer (A) or, in the terms of Ide et al.'s teaching a graft-polymer latex, comprising
 - a rubber (or rubber latex) selected from the group consisting of a diene rubber, an alkyl acrylate rubber and an EPDM rubber, and
 - a graft selected from the group consisting of polystyrene, copolymers of styrene and acrylonitrile, copolymers of α -methylstyrene and acrylonitrile, and copolymers of styrene, α -methylstyrene and acrylonitrile,
- (2) a certain polymer (B) selected from the group consisting of polystyrene, copolymers of styrene and acrylonitrile, copolymers of α -methylstyrene and acrylonitrile, and copolymers of styrene, α -methylstyrene and acrylonitrile,

As such, the molding composition which is employed in accordance with applicants' method differs from the resin (I) of Ide et al. in the nature of the terpolymer.

7) Cf., e.g., col. 3, indicated lines 17 to 25, of US 3,919,157.

8) Cf. page 2, lines 17 to 19, of the Office action, emphasis added.

Serial No. 10/797,092

OEPPEN et al.

PF 50817-02

To constitute anticipation, all material elements of the invention as claimed must be found in one prior art source,⁹⁾ and anticipation under Section 102 can be found only if a reference shows exactly what is claimed.¹⁰⁾ The test for anticipation is one of identity, and the identical invention must be shown in the reference in as complete detail as is contained in the claim.¹¹⁾ In fact, the Federal Circuit has stated that it is error to treat claims as a catalog of separate parts, in disregard of the part-to-part relationships set forth in the claims that give those claims their meaning.¹²⁾

The foregoing clearly shows that the teaching of *Ide et al.* fails to show all elements of applicants' molding composition and, correspondingly, fails to identically describe applicants' invention in as complete detail as is contained in applicants' claims. The reference can therefore not reasonably be taken to anticipate applicants' method under Section 102. Accordingly, it is respectfully urged that the rejection of Claims 9 to 14 under 35 U.S.C. §102(b) be withdrawn. Favorable action is solicited.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit Account No. 14.1437. Please credit any excess fees to such deposit account.

Respectfully submitted,

NOVAK DRUCE DELUCA & QUIGG


James Remenick

Reg. No. 36,902

Customer No.: 26474
1300 Eye Street, N.W.
Suite 400 East Tower
Washington, D.C. 20005
(202) 659-0100

JR/BAS

9) Cf. *In re Marshall*, 577 F.2d 301, 198 USPQ 344 (CCPA 1978); *In re Kalm*, 378 F.2d 959, 154 USPQ 10 (CCPA 1967).

10) Cf. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

11) Cf. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989).

12) Cf. *Lindemann Maschinenfabrik v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).